

REMARKS

It is respectfully requested that this application be reconsidered in view of the above amendments and the following remarks and that all of the claims remaining be allowed.

Request for Continued Examination

Applicants hereby request continued examination of the present application under 37 C.F.R. §1.114.

Personal Interview:

Applicants wish to thank Examiners Liu and Carlson for the courtesy extended to applicants and applicants' representative during the interview held March 10, 2004. The amendments and remarks made herein are made further to the discussions which occurred during the interview.

Specification Amendments:

The specification has been amended as suggested by the Examiner and to correct typographical errors. Withdrawal of the objection is requested.

Abstract Amendments:

The abstract has been amended as suggested by the Examiner. Withdrawal of the objection is requested.

Claim Amendments:

Claims 39 and 40 have been amended. New claims 41-52 have been added.

Claim 39 has been amended to recite that the claimed polypeptide contains less than 60 amino acid residues and comprises at least one of the enumerated sequences which contain the

BX7B sequence. Support for this amendment and for new claims 41-44 may be found, for example, at page 8, lines 25-26 of the specification. Claim 39 has been further amended to spell out hyaluronic acid instead of using the abbreviation HA. New claim 46 is drawn to compositions comprising a carrier, excipient or diluent. Support for this claim may be found, for example, at page 71, lines 20-22 of the specification. New claim 47 is drawn to compositions adapted for administration by one of the routes enumerated therein. Support for this claim may be found, for example, at page 9, line 28 and page 72, lines 1-3 of the specification. New claim 48 is drawn to compositions which deliver a dose of polypeptide at the dose range enumerated therein. Support for this claim may be found, for example, at page 72, lines 10-12 of the specification.

New claims 49-52 are drawn to methods of treating various conditions by administering at least one polypeptide according to any of claims 39 or 41-45 or at least one condition according to any of claims 40 or 46-48. Support for these claims may be found, for example, at page 2, lines 18-20 and page 4, lines 10-21 of the specification.

No new matter has been added by these amendments. The Examiner is hereby requested to enter these amendments.

Supplemental Information Disclosure Statement (IDS):

Applicants submit herewith a Supplemental Information Disclosure Statement and copies of the references cited therein.

Specification/Abstract/Claim Objections:

The examiner's objection to the specification, abstract and claims because of informalities is respectfully traversed in view of the above amendments. Withdrawal of the objections is requested.

Rejections Under 35 U.S.C. § 112:

The Examiner's rejection of Claims 39 and 40 under 35 U.S.C. §112, second paragraph as indefinite is respectfully traversed in view of the above amendments.

The Examiner's rejection of Claims 39 and 40 under 35 U.S.C. §112, first paragraph as allegedly not enabled is respectfully traversed in view of the above amendments. While applicants believe that they have provided sufficient representative species which fall within the BX7B structure to enable the genus, they have amended the claims so that they are limited to polypeptides of less than 60 amino acids which comprise certain enumerated sequences. This amendment was made solely to expedite the prosecution of this application.

Withdrawal of the rejections is requested.

Rejections Under 35 U.S.C. § 102:

The Examiner's rejections of Claims 39 and 40 under 35 U.S.C. §102(b) as anticipated by Turley (WO97/38098) or Turley (WO93/21312) are respectfully traversed.

The claims have been amended to claim a polypeptide of less than 60 amino acid residues comprising at least one amino acid sequence BX7B (SEQ ID NO: 28) which binds hyaluronic acid, wherein said amino acid sequence is selected from the group consisting of SEQ ID NO: 2, SEQ ID NO: 3, SEQ ID NO: 4, SEQ ID NO: 5, SEQ ID NO: 26, SEQ ID NO: 27, SEQ ID NO: 51, SEQ ID NO: 56, SEQ ID NO: 57, SEQ ID NO: 58, SEQ ID NO: 64, SEQ ID NO: 66, SEQ ID NO: 69 and SEQ ID NO: 71. As noted in the Examiner's interview summary, these claims are free of the previously cited prior art.

Withdrawal of the rejections is requested.

Double Patenting Rejection:

The Examiner's provisional rejection of claims 39 and 40 as unpatentable under the judicially created doctrine of obviousness type double patenting over the claims of co-pending application Serial No. 09/987,309 is respectfully traversed. As discussed at the interviews, the claims of this application are drawn to sequences which the Examiner deemed, in his restriction

requirement, to be patentably distinct from the sequences to which the claims of co-pending application Serial No. 09/987,309 are drawn.

Withdrawal of the rejection is requested.

Conclusions:

For the reasons set forth above, applicants submit that the claims of this application are patentable. Reconsideration and withdrawal of the Examiner's objections and rejections are hereby requested. Allowance of the claims of this application at an early date is earnestly solicited.

In the event that a telephone conversation could expedite the prosecution of this application, the Examiner is invited to call the undersigned at (650) 839-5122.

Enclosed is a \$385 check for the RCE fee required under 37 CFR 1.17(e) and a \$9 check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 3/23/04

\_\_\_\_\_  
Mary Ann Dillahunt  
Reg. No. 34,576

Fish & Richardson P.C.  
500 Arguello Street, Suite 500  
Redwood City, California 94063  
Telephone: (650) 839-5070  
Facsimile: (650) 839-5071